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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,896	07/27/2000	Man Sung Co	GNN-5315DVI	2462

25291 7590 02/26/2002

AMERICAN HOME PRODUCTS CORPORATION
FIVE GIRALDA FARMS
PATENT LAW
MADISON, NJ 07940

EXAMINER

GAMBEL, PHILLIP

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 02/26/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.



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1644 10

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 12/31/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
Of the above, claim(s) 5 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

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DETAILED ACTION

1. Applicant's election of Group I (claims 1-4) as it reads on transplantation with traverse in Paper No. 9 is acknowledged. In the interest of compact prosecution, the election of transplantation will be considered a species election, as submitted by applicant.

Therefore, applicant's election of Group I (claims 1-4), as it reads on transplantation is considered an election without traverse.

Claim 5 has been withdrawn from consideration by the examiner 37 CFR 1.142(b), as being drawn to nonelected invention and/or species

2. The application is required to be reviewed and all spelling, TRADEMARKS, and like errors corrected.

Trademarks should be capitalized or accompanied by the TM or ® symbol wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the trademarks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate corrections are required

3. Claims 2-3 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3 are indefinite in its recitation of "modulating" and "treating" because it is ambiguous as to the nature, direction (positive or negative) or degree of said "modulating" or "treating".

Applicant is invited to limit the claims to "inhibiting" as it reads on the elected invention and to clearly defined the nature of the claimed methods (e.g. endpoint).

The applicant is reminded that the amendment must point to a basis in the specification so as not to add any new matter. See MPEP 714.02 and 2163.06

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being anticipated by Freeman et al. (U.S. Patent No. 6,130,316) (see entire document). Freeman et al. teach the use of B7-2-specific antibodies, including recombinant antibodies thereof (columns 25-28), in order to cause immunosuppression or induce tolerance, including their use to inhibit transplant rejection in various modalities (columns 28-32). In addition, Freeman et al. Teach the use of inhibitory B7-2-specific antibodies in combination with other immunosuppressive reagents (columns 28-32). Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations and constructions encompassed by the claims would be inherent properties of the referenced methods to inhibit transplant rejection with B7-2-specific recombinant antibodies.

7. Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being anticipated by de Boer et al. (U.S. Patent No. 6,346,248) (see entire document). De Boer et al. teach the use of B7-2-specific immunotoxins, including recombinant antibodies thereof (columns 7, paragraphs 7 to column 8, paragraph 1 and columns 14-18), in order to cause immunosuppression, including their use to inhibit transplant rejection in various modalities (column 8, paragraph 10 to column 11, line 8 and column 19, paragraph 4 to column 20, paragraph 7). Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations and constructions encompassed by the claims would be inherent properties of the referenced methods to inhibit transplant rejection with B7-2-specific recombinant antibodies.

8. No claim is allowed.

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Art Unit 1644

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

PHILLIP GAMBEL

Phillip Gambel, Ph.D.
Primary Examiner
Technology Center 1600
February 25, 2002